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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-------------------------|------------------------------|------------------|
| 10/849,497 | 05/19/2004 | Hajime Mizutani | U 015200-1 | 6008 |
| 140 7590 01/08/2007 LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023 | | | EXAMINER SPEER, TIMOTHY M | |
| | | | ART UNIT 1775 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS | | MAIL DATE 01/08/2007 | DELIVERY MODE PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/849,497

Applicant(s)

MIZUTANI ET AL.

Examiner

Timothy M. Speer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution Reopened

1. In view of newly discovered prior art, prosecution on the merits is reopened, consistent with the grounds of rejection set forth herein. Applicant's period for response is set to expire three months from the mailing date of the present Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamikubo (US 2003/0138599).

4. Regarding independent claim 1, Kamikubo teaches image-protecting films having a protective layer releasably laminated on a support to be heat transferred onto an image of recorded matter, wherein the surface of the support on which the protective layer is laminated has a surface roughness, R_a , of not less than 0.100 (abstract and paragraph [0032], for instance). Thus, Kamikubo teaches that surface roughness is a result effective variable and, moreover suggests optimizing this variable to be greater than 0.1. Kamikubo does not teach that the surface roughness is 0.2 to 0.5, as presently claimed. However, it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the

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optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In the present case, Kamikubo teaches that the surface roughness should be greater than 0.100. Accordingly, to discover optimum or workable ranges with respect to surface roughness would have been obvious to one having ordinary skill in the art, since Kamikubo teaches that surface roughness is a result effective variable and, moreover, suggests that the surface roughness should be greater than 0.100.

5. With respect to claim 2, Kamikubo teaches that the protective layer have a 60 degree specular gloss according to JIS-Z8741 of less than 65%, preferable 20 to 30% (paragraph [0078]). Accordingly, Kamikubo suggests a surface roughness of 10 to 30%, as set forth in the present claims.

6. Regarding claims 3-5, 10-12, 14, and 15, Kamikubo teaches that the support may be formed of polyesters, such as polyethylene terephthalate and include inorganic fillers (paragraphs [0031] and [0032]). Kamikubo further teaches that the support may be roughened by spraying with inorganic particles (paragraph [0032]) and protective layer may comprises a protective layer and an adhesive layer laminated from the support side (figure 2 and accompanying text).

Regarding the protective layer, Kamikubto teaches that it may be formed of mixtures of thermoplastic resins (paragraph [0048]). Accordingly, to select appropriate resins based on the disclosure lies within the level of ordinary skill in the art and is considered to be prima facie obvious; this merely requiring the discovery of optimum or workable materials. Kamikubo further teaches that the protective layer may include waxes and finely divided silica, as recited in the present claims. Discovering optimum or workable amounts of such materials, as recited in claims 11 and 15 is considered to be prima facie obvious.

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7. With respect to claims 7-9 and 16-18, Kamikubo teaches that the articles disclosed therein may be used in image protecting methods, such as those claimed. Such a method results in an article as set forth in instant claim 9 (see abstract).

8. In light of the above, it is the Examiner's position that the present claims are prima facie obvious in view of the applied prior art.

Conclusion

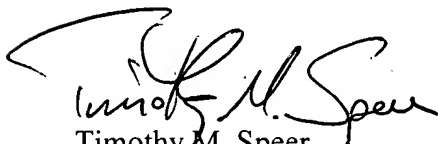
9. Applicant's arguments filed 11/06/06 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Timothy M. Speer



JENNIFER MCNEIL
SUPERVISORY PATENT EXAMINER
1/4/07